

## **REMARKS**

### **Summary**

This paper is filed in response to the Office Action mailed on May 12, 2003 (“Office Action”). After entry of the amendment, claims 1-47 are pending. Claims 1, 4-8, 14-19 and 21-27 are herein amended and new claims 28-47 are herein added. Claims 1-27 were rejected in the Office Action.

### **Objections to Specification and Title**

In the Office Action at p. 2 ¶ 1, Examiner objects to the specification requesting that the embedded hyperlinks be removed. In the Office Action at p.1, ¶ 2, Examiner requests that Applicant correct any minor errors in the specification. In the Office Action, at p. 1, ¶ 3, Examiner states that the title is not descriptive and that a new title is required. In response to these objections, Applicant herein submits amendment to the specification and title. Applicant believes these amendments address Examiner’s stated concerns and respectfully requests Examiner to withdraw the objections.

### **Claim Objections**

In the Office Action at p. 2 ¶ 4, Examiner objects to claims 1-27 stating that (1) the word “websites” should be stated as “website’s”, and (2) that the terms “filename” and “file name” should be used consistently. In response to these objections, Applicant herein submits amendment to claims 18-19, changing “filenames” to “file names” and amendment to claims 1 and 25-27, changing “websites” to “website’s”. These amendments are for reasons unrelated to

patentability and Applicant does not surrender any patentable subject-matter. Applicant believes these amendments address Examiner's stated concerns and respectfully requests Examiner to withdraw the objections.

**Claim Rejections under 35 U.S.C. § 112 ¶ 1**

In the Office Action at pp. 2-3 ¶¶ 5-6, Examiner states that claim 22 is rejected under 35 U.S.C § 112, ¶ 1 as containing subject-matter which was not described in the specification in a way as to enable one skilled in the art to use the invention. Applicant respectfully traverses this rejection. For example and without limitation, Applicant refers Examiner to Figures 20-21, Figures 26-29, and the description of the figures on pages 31-33 of the specification. Applicant submits that the specification and drawing disclose the invention of claim 22 to a sufficient degree to enable one skilled in the art to make the invention. Applicant respectfully requests that Examiner reconsider and allow claim 22.

**Claim Rejections under 35 U.S.C. § 112 ¶ 2**

In the Office Action, at pp. 3-4, ¶¶ 7-10, Examiner states that claims 7, 12-16 and 21-24 are rejected under 35 U.S.C § 112, ¶ 2 as failing to particularly point out and distinctly claim the subject matter of the application. Examiner states that claims 7 and 14 recite "internet cataloging engine" while claim 1 recites "internet cataloging website." Applicant herein submits amendment to claims 4-7, 14-17, and 24-27 so that claims 1-27 uniformly refer to an "internet cataloging engine" rather than an "internet cataloging web site", "internet cataloging search engine", and/or "search engine". These amendments are solely for the purposes of maintaining

consistent terminology throughout the claims, are not for reasons related to patentability, and no subject-matter is surrendered.

Examiner also states that claims 21-24 are assumed to depend from claim 20. Examiner's assumption is correct and Applicant herein submits amendment to claims 21-24 changing their dependency to claim 20.

Applicant believes that Examiner's stated concerns have been herein addressed and respectfully requests Examiner to reconsider and allow rejected claims 7, 12-16 and 21-24.

**Claim Rejections under 35 U.S.C. § 102(b)**

In the Office Action, at pp. 4-11, Examiner states that claims 1-27 are rejected under 35 U.S.C. § 102(b) as being anticipated by "Archiving on the Internet" by Brewster Kahle, published 4 November 1996 ("Archiving"). Examiner makes primary reference to pp. 3-4, section "Technical Issues of Gathering Data," ¶ 4 and makes additional reference to other paragraphs in Archiving.

The rejection is herein mooted since Applicant herein submits amendment to claim 1, stating "each submission being made in accordance with a set of rules associated with the corresponding Internet cataloging engine." However, Applicant submits that the claim is patentable based on the "submission" features that were present in the claims prior to amendment and that remain in the claims subsequent to amendment.

Archiving does not disclose the submission features of the inventions. While Archiving addresses search engines, Archiving does not discuss methods for submitting to engines. No where does Archiving disclose or suggest "determining if the file name is to be submitted to an Internet cataloging" website and/or engine nor does it disclose or suggest "submitting... to at

least one Internet cataloging” website and/or engine.” Archiving only discusses search engines themselves retrieving this information, and in fact states that the techniques it discussed are applicable to search engines (see p. 4, ¶ 1 with reference to Alta Vista). The submission of information to a search engine is a technologically distinct procedure from the retrieval of information by a search engine. Archiving fails to disclose or suggest all of the claim elements and, for at least this reason, Applicant submits that independent claim 1 is patentable and respectfully requests immediate allowance.

As an additional and independent ground for patentability, Applicant respectfully submits that Archiving is a non-enabling disclosure and, as such, cannot appropriately form the basis of a rejection absent extrinsic evidence that Archiving is enabling. See In re Donahue, 766 F.2d 531, 226 U.S.P.Q. 619 (Fed. Cir. 1985); In re Samour, 571 F.2d 559, 197 U.S.P.Q. 1 (CCPA 1978). Archiving is clearly a soft article written for the nonprofessional readership of the *Scientific American*. Archiving articulates scientific concepts in laymen’s terms and does not present any appreciable technical insight on the issues it touches upon. Thus, independent of what Archiving does and does not disclose in relation to the claimed invention, the depth of disclosure is not sufficient to enable one in the art to make and/or use the concepts that it discloses. “Even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling.” In re Donahue, 766 F.2d at 533, 226 U.S.P.Q. at 621. For at least these reasons, Applicant respectfully requests that the Examiner withdraw the rejection and allow claim 1.

Because Applicant believes that independent claim 1 is patentable and because claims 2-24 depend either directly or indirectly from independent claim 1, Applicant believes that claims 2-24 are patentable at least by virtue of their dependency from a patentable claim. Applicant

reserves the right to argue the patentability of each of claim 2-24 on other grounds in this and/or another proceeding. For at least these reasons, Applicant respectfully requests Examiner to reconsider and allow claims 2-24.

As to independent claims 25-27, the rejections are herein mooted since Applicant herein submits amendment. However, Applicant believes that the claims are patentable at least for reasons analogous to those stated above regarding the pre-existing claim feature relating to "submission." Applicant respectfully requests that Examiner reconsider and allow claims 25-27.

**Claim Rejections under 35 U.S.C. § 103(a)**

In the Office Action, at p. 11, Examiner states that claim 24 is rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 5,659,732 ("Kirsch"). Because Applicant believes that independent claim 1 is patentable and because claim 24 depends from independent claim 1, Applicant believes that claim 24 is patentable at least by virtue of its dependency from a patentable claim. Applicant reserves the right to argue the patentability of claim 24 on other grounds in this and/or another proceeding. For at least these reasons, Applicant respectfully requests Examiner reconsider and allow claim 24.

**New Claims 28-47**

Applicant herein adds new claims 28-47. Each claim incorporates the feature of submission discussed above and is patentable for at least that reason. Applicant respectfully requests that Examiner consider and allow claims 28-47.

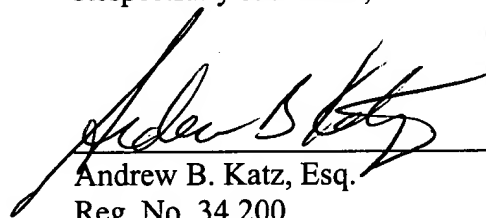
**CONCLUSION**

Applicant believes that Applicant has fully responded to the Examiner's concerns and that all claims are in condition for allowance. Applicant respectfully requests that Examiner immediately allow all claims.

Applicant requests that any questions concerning this matter be directed to the undersigned at (215) 299-2782.

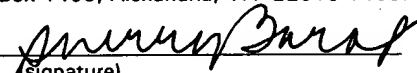
Respectfully submitted,

Date: September 5, 2003

  
\_\_\_\_\_  
Andrew B. Katz, Esq.  
Reg. No. 34,200  
Attorney for Applicant  
Fox Rothschild LLP  
2000 Market Street, 10<sup>th</sup> Floor  
Philadelphia, PA 19103-3291  
Tel: 215-299-2782  
Fax: 215-299-2150

**CERTIFICATE OF MAILING  
UNDER 37 C.F.R. 1.8(a)**

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

\_\_\_\_\_  
(signature)   
BY: Sherry BARAG  
DATE: Sept 5/2003